

REMARKS

Claims 22 and 25-42 remain in the application. Claim 32 has been amended.

Prior Art Rejection of the Claims

On page 2 of the above-identified Office Action, claims 32-42 have been rejected as being anticipated by *Awano* (US 2002/0163079) under 35 U.S.C. § 102.

Allowance of Claims

On page 4 of the Office Action, claims 22 and 25-31 have been allowed.

Reply to the Prior Art Rejection

In the "Response to Arguments" section on page 4 of the Office Action, the Examiner states:

... Applicant has not provided any evidence to support this assertion. Specifically, Applicant has not disclosed any element of the nanoelement arrangement **product**, as recited in claim 32 that is different from the nanoelement arrangement **product** of *Awano*. ... See MPEP 2113, "Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with *evidence* establishing an unobvious difference between the *claimed product* and the *prior art product* [emphasis added]. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983)."

The Examiner's comments have been considered, and claim 32 has been amended accordingly.

Claim 32 now recites, *inter alia*:

... wherein the first nanoelement is covered with the catalyst material by bringing the first nanoelement into operative contact with a suspension having clusters of catalyst material and an *ingredient that serves as a bonding layer to thereby improve the bonding between the catalyst*

material and the first nanoelement, and removing the first nanoelement with at least one cluster attached thereto from the suspension;
(Emphasis added.)

Support for the amendment to claim 32 can be found in the instant application at:

[0022] The invention is based on the experimental discovery that catalyst material, for example in the form of metallic clusters, bonds particularly well to nanoelements a cobalt cluster may be surrounded by a monolayer of an organic material, which *monolayer* has a *good bonding action* with carbon nanotubes.

[0058] ... The oleic acid sheath by which the iron clusters 102 are surrounded evidently serves as a *bonding layer* for bonding the iron clusters 102 to the carbon nanotubes 110. This makes it possible for iron clusters 102 to be attached only to spatially defined locations on the carbon nanotubes, as catalyst material spots for catalyzing subsequent formation of second carbon nanotubes.

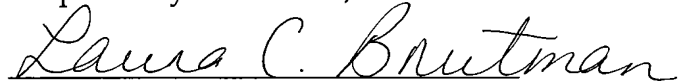
(Emphasis added.)

The above-cited passages of the instant application explains clearly (and is evidence) why the product-by-process feature results in a *different* product that of *Awano*. There is no disclosure or suggestion in *Awano* of a bonding layer or of an ingredient improving the bonding between the catalyst material and the nanoelement. The invention as recited in amended claim 32 of the instant application is therefore not to anticipated by *Awano*. Claim 32 is, consequently, patentable, and because claims 33-42 are ultimately dependent on claim 32, they are patentable as well.

In view of the foregoing, reconsideration and allowance of claims 32-42 are solicited. (The Examiner already stated that claims 22-31 are allowable.)

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Respectfully submitted,

A handwritten signature in cursive script that reads "Laura C. Brutman". The signature is written in dark ink and is positioned above the printed name.

Laura C. Brutman

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